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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/649,536	08/26/2003	Andrew Jeremiah Burns	2003P12748US	5435

7590 12/28/2006
Siemens Corporation
Intellectual Property Department
170 Wood Avenue South
Iselin, NJ 08830

EXAMINER

HEINRICH, SAMUEL M

ART UNIT	PAPER NUMBER
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1725

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/28/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/649,536

Applicant(s)

BURNS ET AL.

Examiner

Samuel M. Heinrich

Art Unit

1725

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6,8-17 and 36-39 is/are pending in the application.
- 4a) Of the above claim(s) 12,38 and 39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6,8-11,13-17,36 and 37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application
- ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Claims 12, 38 and 39 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on October 10, 2006.

The Species remaining after Applicant's Amendment received October 10, 2006:

Species I: Claims 1-6, 8-11, 13-7, 36, and 37.

Species II: Claim 12.

Species III: none.

Species IV: Claims 38 and 39.

The species are independent or distinct because each group of claims requires specific features not found in the other species. Species I requires a gap width of "less than 100 microns". Species II requires a "pattern of grooves". Species IV requires a void fraction.

Applicant's election with traverse of Group I in the reply filed on October 10, 2006 is acknowledged. The traversal is on the ground(s) that the claims have a clear relationship. This is not found persuasive because each Species requires particular features not found in the other Species. The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-6, 8-11, 13-17, 36, and 37 rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,951,892 to Wolfa et al in view of US20030209859A1 to Young et al and in view of USPN 6,443,813 to Strom et al and in view of USPN 6,676,878 to O'Brien et al. Wolfa et al describe (Abstract) texturing deposited ceramic material by "utilizing a laser to cut a pattern into the surface". The laser cut depth is 0.01 to 0.1 inch (254 microns to 2.54 mm). Young et al and Strom et al and O'Brien et al all describe multiple passes of a laser and all describe multiple laser energy parameters associated with the passes. The use of multiple passes and multiple laser energy parameters in a laser cutting process would have been obvious at the time applicant's invention was made to a person having ordinary skill in the art because they

provide variability to processes of manufacture in laser processing of ceramics. The particular claimed size of the gap would have been obvious as a change in shape for some intended use. The dependent claims modify sizes, shapes, spacings, multiple shapes, laser delivery, etc., would have been obvious at the time applicant's invention was made to a person having ordinary skill in the art depending on the particular layered work piece.

Claims 16, 17, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,951,892 to Wolfa et al in view of US20030209859A1 to Young et al and in view of USPN 6,443,813 to Strom et al and in view of USPN 6,676,878 to O'Brien et al as applied to claim 1 above, and further in view of US 20030101587A1 to Rigney et al and in view of US20040266615A1 to Watson et al. Both Rigney et al (repairing a damaged engraved layer) and Watson et al (forming multiple layers for multiple channels) describe surface deposit of ceramic material, etching the surface, and again depositing and laser grooving the surface in repair of buildup manufacture. The plural coating would have been obvious at the time applicant's invention was made to a person having ordinary skill in the art depending on intended use.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.


Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samuel M. Heinrich whose telephone number is 571-272-1175. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, P. Ryan can be reached on 571-272-1292. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Samuel M Heinrich
Primary Examiner
Art Unit 1725

SMH